

present application. [Office Action, ¶ 17]. Consequently, it is Applicants' understanding that the withdrawal of the *Hartung, et. al.* reference as prior art depends solely upon the submission of specific factual evidence of the lengthy study and negotiations that were conducted during the time period "from a date just prior to April 4, 1994 until July 1994" to determine what type of lithographic presses should be purchased. [Office Action, ¶ 17]. For that purpose, Applicants submit herewith the Declaration of Jerry Williamson under 37 C.F.R. 1.131 ("J. Williamson Dec.').

The subject matter of the apparatus and methods of the rejected claims is directed to the unique integration of lithographic and flexographic printing stations as specifically defined by these claims. As previously attested to in the recently filed 5/29/2008 Supplemental Declaration of Bill L. Davis [Davis Supp. Dec., ¶ 7], and as now further attested to in the enclosed Jerry Williamson Declaration [J. Williamson Dec., ¶ 3], there was no existing equipment on the market in 1994 that provided the required in-line integrated arrangement of flexographic and lithographic print stations upon which the process of the invention could be implemented. Therefore, in connection with the investigation in 1994 by Williamson Printing Corporation ("WPC"), the assignee of the pending application, to find appropriate lithographic presses to replace its then aging fleet of lithographic sheetfed and web presses, this investigation also required that the lithographic presses to be purchased be of a type that would enable the in-line flexographic print station integration required by the claimed invention. [J. Williamson Dec., ¶ 3]. A detailed summary of that investigation, as well as the lengthy study and negotiations in connection therewith, particularly during the time period commencing just prior to April 4, 1994 and extending through July of 1994, is described in the Jerry Williamson declaration and is now summarized.

For example, the German press manufacturer, MAN Roland, was contacted in March 1994 and requested to submit its proposal for furnishing the lithographic printing presses that were needed. [J. Williamson Dec., ¶ 4, Exs. 1, 2]. At about the same time, and principally because information was received by Mr. Williamson that the lithographic presses of the German press company, Heidelberger Druckmaschinen, were particularly amenable to the required in-line

flexographic station integration, WPC also requested a proposal from Heidelberg's U.S. subsidiary, Heidelberg USA.

Heidelberg USA submitted the requested proposal for consideration by WPC in early April 1994 for purchase of Heidelberg offset lithographic presses. [J. Williamson Dec., ¶ 5, Ex. 3]. Heidelberg USA personnel subsequently traveled to WPC's headquarters in Dallas, Texas and made two follow-up confidential presentations, May 19, 1994 and June 7, 1994, to the inventors and other WPC personnel. [J. Williamson Dec., ¶ 5, Exs. 4, 5]. The increasing interest by WPC and the inventors in the Heidelberg lithographic press at that time, and its potential suitability for the in-line integration with a flexographic print station required to implement this new technology, are clearly evident from a review of Mr. Williamson's sworn testimony, as well as the supporting documents accompanying such testimony. [J. Williamson Dec., ¶ 5, Exs. 4-5].

Even though the Heidelberg presses appeared to be particularly suited for WPC's needs, to make certain of that choice, WPC personnel, including the inventors, Jesse Williamson and Bill Davis, further investigated the presses of the manufacturers, Komori and MAN Roland, as well as other Heidelberg presses, during June 1994. [J. Williamson Dec., ¶ 6, Ex. 7]. A comprehensive report and recommendation regarding all of these investigated lithographic presses was then requested by Mr. Williamson. [J. Williamson Dec., ¶¶ 7, 8, Exs. 8, 9]. This report was provided on July 5, 1994, with the recommendation to purchase the Heidelberg lithographic presses. [J. Williamson Dec., ¶ 8, Ex. 10]. As a consequence, on July 7, 1994, a confidential letter of intent was sent by WPC to Heidelberg USA to purchase the recommended Heidelberg lithographic presses, subject to agreement on additional details, including pricing and financing. [J. Williamson Dec., ¶ 8, Ex. 11].

Thereafter, during the remainder of July 1994, WPC extensively negotiated with Heidelberg the terms and conditions of WPC's purchase of the Heidelberg offset lithographic sheetfed presses, including face to face negotiations in Germany. [J. Williamson Dec., ¶9, Ex. 12]. On August 1, 1994, WPC forwarded to Heidelberg USA the formal executed contracts to purchase the Heidelberg presses. [J. Williamson Dec., ¶ 9, Ex. 13].

With the selection of the Heidelberg lithographic presses, the in-line integration of the flexographic print station was then pursued in parallel tracks, by (i) the auxiliary "add-on"

approach, commencing in late July with Printing Research, Inc., and (ii) the dedicated equipment approach, pursued later with Heidelberg, all as set out in the previously filed 5/29/2008 Supplemental Declaration of Bill Davis. [Davis Supp. Dec., ¶¶ 7, 8].

CONCLUSION

It is therefore believed apparent from the sworn detailed testimony of Mr. Jerry Williamson that prior to April 4, 1994, indeed at least as early as March 1994, the assignee of the present application and the inventors were extensively investigating different lithographic presses of various manufacturers not only suitable to replace WPC's fleet of aging presses, but also having the capability of in-line integration with a flexographic print station — the prerequisite to implementation of the claimed inventions of the '363 patent. This in-depth investigation eventually led to the selection of the Heidelberg lithographic press as the preferred choice, followed by extensive negotiations in Germany and the United States regarding the purchase terms, then followed by the purchase of the selected Heidelberg presses.

Accordingly, it is believed that Applicants have provided the sufficiently detailed factual evidence requested by the Examiner during the time period commencing just prior to April 4, 1994 until July 1994. Therefore, it is respectfully requested that the Examiner accept such evidence and find that Applicants, with the submission of all the declarations, have now not only provided sufficient evidence of prior conception, but also of the diligence required to reduce the invention to practice. Accordingly, Applicants request that the *Hartung* reference now be withdrawn as prior art, and in view of such withdrawal, that currently rejected claims 6-11, 15-30, 32-38, 58, 153, 154, 156, 158, 161-165 and 167 be allowed, along with presently allowed claims 1-5, 12-14, 39-41, and 82-84, and the case advanced to issue.

To the extent that any further fees are required during the pendency of this Application, including petition fees, the Commissioner is hereby authorized to charge payment of any additional fees, including, without limitation, any fees under 37 C.F.R. § 1.16 or 37 C.F.R. § 1.17, to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP and reference Attorney Docket No. 111667-1000. In the event that any additional time is needed for this filing, or any additional time in excess of that requested in a petition for an extension of time, please consider

this a petition for an extension of time for any needed extension of time pursuant to 37 C.F.R. § 1.136 or any other section or provision of Title 37. Applicants respectfully request that the Commissioner grant any such petition and authorize the Commissioner to charge the Deposit Account referenced above. Please credit any overpayments to this same Deposit Account. This is intended to be a complete response to the Office Action mailed July 9, 2008.

Respectfully submitted,



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